

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Franck Le

Title: IPV6 ADDRESS OWNERSHIP SOLUTION BASED ON
ZERO-KNOWLEDGE IDENTIFICATION PROTOCOLS OR
BASED ON ONE TIME PASSWORD

Appl. No.: 10/615829

Filing Date: 7/10/2003

Patent No. 7,546,456

Grant Date: 6/9/2009

Examiner: Yogesh Paliwal

Art Unit: 2435

Confirmation Number: 8920

**RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully renew their request for reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent. The USPTO indicated in the letter mailed March 27, 2009 (copy attached), that a decision on the Applicants' initial request was being held in abeyance until after the actual patent date. As noted, the patent issued on June 9, 2009, as U.S. Patent No. 7,546,456.

The Patent Office determined that the patent was entitled to 580 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 894 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	1074 days
(b) Total Applicant delay:	180 days
Final PTA Determination:	894 days

Applicants therefore respectfully request that the patent be accorded 894 days PTA.

The patent is not subject to a terminal disclaimer.

Because this is a renewed request, Applicants do not believe that any fee is due, the fee having been paid with the Applicants' original request on March 6, 2009. However, if a fee is due, and should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date July 24, 2009

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4263
Facsimile: (608) 258-4258

By



Callie M. Bell
Attorney for Applicant
Registration No. 54,989



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

FOLEY & LARDNER LLP
150 EAST GILMAN STREET
P.O. BOX 1497
MADISON WI 53701-1497

MAILED

MAR 27 2009

OFFICE OF PETITIONS

In re Application of	:	
LE et al.	:	
Application No. 10/615,829	:	ON APPLICATION FOR
Filed: July 10, 2003	:	PATENT TERM ADJUSTMENT
Attorney Docket No. 088245-0111	:	

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705 filed March 6, 2009, which is properly treated under 37 CFR 1.705(b). Applicant requests that the determination of patent term adjustment be corrected from 653 days to 967 days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, a decision is being held in **abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within three years. See 37 CFR 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness

of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that applicant is correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was filed in this application on August 20, 2007.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney, Christina Tartera Donnell, at (571) 272-3211.



Kery A. Fries
Senior Legal Advisor
Office Patent Legal Administration

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 088245-0111
Application Number: 10/615829
Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	07/10/2003	0		
	14 month From Application date	09/10/2004	428		
	3 Year Period Starts	07/10/2006	1,096		
Edit Delete	Non-Final Office Action	10/10/2006	1,188	(760)	
	Non-Final Office Action + 3 months	01/10/2007	1,280		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/12/2007	1,313		33
Edit Delete	Final Office Action	05/18/2007	1,408		
	Final Office Action + 3 months	08/18/2007	1,500		
Edit Delete	Request For Continued Examination (including amendment)	08/20/2007	1,502	(406) 1074	2
	3 Year Period Stopped	08/20/2007	1,502		
Edit Delete	Non-Final Office Action	11/01/2007	1,575		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/01/2008	1,667		
Edit Delete	Restriction Requirement	04/21/2008	1,747		
Edit Delete	Restriction Requirement Response Received at PTO	05/02/2008	1,758		
Edit Delete	IDS under 1.704(c)(8) filed at PTO	06/12/2008	1,799		41
Edit Delete	Final Office Action	08/01/2008	1,849		
Edit Delete	Final Office Action Response Received at PTO	09/25/2008	1,904		
Edit Delete	Advisory Action	10/20/2008	1,929		
	Final Office Action + 3 months	11/01/2008	1,941		
Edit Delete	Notice of Appeal Received at PTO	12/02/2008	1,972		31
Edit Delete	Appeal Brief Received at PTO	12/08/2008	1,978		
Edit Delete	Notice of Allowance	02/06/2009	2,038		
Edit Delete	Post-Allowance Document Received at PTO	03/06/2009	2,066		
Edit Delete	Supplemental Notice of Allowability	04/07/2009	2,098		33
Edit Delete	Issue Fee Paid	05/01/2009	2,122		
Edit Delete	Post-Allowance Document Received at PTO	05/01/2009	2,122		

Edit Delete

Patent Grant Date

06/09/2009

2,161

40

Totals:

1,074

180

PTA:

894



Version: 3.02.05

LOGIN: Linda Anderson

IP: 10.24.4.21

Foley & Lardner LLP